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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/552,834 04/20/00 YOUNKER

C 99-0925

EXAMINER

MMC2/0509

SAWHNEY, H

ART UNIT

PAPER NUMBER

ATTN IVAR M KAARDAL  
KAARDAL & ASSOCIATES PC  
3500 SOUTH FIRST AVENUE CIRCLE SUITE 250  
SIOUX FALLS SD 57105-5807

2875

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/552,834

Applicant(s)

YOUNKER, CLAYTON R.

Examiner

Hargobind S Sawhney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "decorative light kit" recited in line 1 of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to because the positioning of the container as specified in line 6-8 on page 10 and detailed in Figure 2 is not shown in shown in figure 1. In addition, the container needs to be identified with a specific part number.  
Correction is required.

### ***Specification***

3. The disclosure is objected to because of the following informalities:  
  
The limitation "kit" recited in line 1 of claim 1 is neither shown in any of the figures nor addressed in the specification. The disclosure needs to provide details of the kit and its contents.  
  
Appropriate correction is required.

4. Claim 1 objected to because of the following informalities

The limitation "kit" recited in line 1 of claim is neither shown in figures nor specified in the specification. The disclosure needs to provide details of the kit and its contents.

Appropriate correction is required.

Claims 2-8 are necessarily objected because of their dependency on the objected base claim 1.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, the limitation "kit" recited in line 1 of claim 1 needs to be specified positively and identified with a respective numeral in the disclosure.

Claim 1, lines 4-5, the limitation "said light assembly being adapted to illuminate a pair of elongated fluorescent light bulb" is not clear. Technically, the light bulbs emit light illuminating the object.

Claim 1, line 4, "adapted to illuminate" should be replaced with "illuminating". It has been held that "adapted to" does not result a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claims 2-10 are also necessarily rejected because of their dependency on the rejected base claim 1.

***Allowable Subject Matter***

7. Claims 1-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose proper motivation for combining a decorative light kit the following features:

- An elongated light assembly having comprising a light housing ( light shade) shaped generally resembling a car as recited in claim 1;
- The light housing positioned between the ceiling and light assembly as recited in claim 1;
- A plurality of accessories for decorating an exterior surface of the light housing as recited in claim 1.

Neither combined nor individual teachings of Lewis et al. (US Patent No. Des 308,113), Davidson et al. (US Patent No. 3,917,264), Van De Kop et al. (US Patent No. 4,882,676) teaches the features claimed by the applicant.

### ***Conclusion***

8. Regarding the 35 U.S.C. 112, second paragraph, rejection of the independent claim 1, the examiner suggested the following revisions which do not add new matter to the original specification.
  - Page 7, line 31, change "decorative light" to "decorative light kit" ;
  - Page 8, line 2, insert – The decorative light kit includes a container holding a plurality of accessories to be used for decoration of an exterior surface of the light housing. Plurality of accessories includes paint, paint brushes, decals and gluing means. -- after "described.". the accessories included in the kit are already detailed on page 9, lines 14-30. Applicant's attorney did not accept the above-indicated suggestion made by the examiner.
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lewis et al. (US Patent No. Des 308,113), Davidson et al. (US Patent No. 3,917,264) , Van De Kop et al. (US Patent No. 4,882,676) each discloses a

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decoration light fixture for a billiard table comprising some of the claimed features including a light assembly, light source and a light housing.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 7:30 - 5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

5/2/2001

  
**ALAN CARIASO**  
**PRIMARY EXAMINER**